

## **REMARKS/ARGUMENTS**

This amendment responds to an Office Action dated May 17, 2007. Claims 1, 5, 6, 8, 11, 12, 14, 15, 18, 19, and 22 are pending. Claims 2-4, 7, 9, 10, 13, 16, 17, 20, and 21 remain withdrawn from consideration. Independent claims 1, 8, 14, and 22 are amended. New claim 23 is added.

The Office Action rejected claims 1, 5, 6, 8, 11, 12, 14, 15, 18, 19, and 22 under 35 USC §112, first paragraph, for failing to comply with the written description requirement. The aforementioned claims were also rejected under 35 USC §112, second paragraph, as being indefinite. Moreover, the same claims were continually rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 1,045,984 to King.

Independent claims 1, 8, 14, and 22, as amended, comply with the written description requirement of 35 USC §112, first paragraph, and are not indefinite under 35 USC §112, second paragraph. Independent claims 1 and 8 now recite "a shim disposed between the wooden member support and sized to substantially prevent horizontal movement therebetween" and claims 14, 22, and 23 recite a shim or rigid block "sized to substantially prevent horizontal movement therebetween when disposed between the wooden member". FIGS. 11-13, which illustrate the elected species, clearly disclose the shim 32 disposed between the joist hanger 20 and sized to prevent horizontal movement therebetween.

Regardless of the actual written description in the detailed description, the "drawings alone may be sufficient to provide the 'written description of the invention' required by § 112, first paragraph." *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1564 (Fed. Cir. 1991) (emphasis added). "The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim

language.” *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983) (citations omitted) (emphasis added).

The above-described claim limitations are sufficiently detailed in FIGS. 12-13 to satisfy the requirements under both the first and second paragraphs of Section 112. “Between” is defined as “in the space separating (two points, objects, etc.)”. between. Dictionary.com. *Dictionary.com Unabridged* (v 1.1). Random House, Inc. [http://dictionary.reference.com/ browse/between](http://dictionary.reference.com/browse/between) (accessed: July 31, 2007). Here, the “two points” or two “objects” can only be the pair of vertically extending sides of the joist hanger 20 having the lateral fasteners 26 therein. There are no other possible locations where the shim 32 could be in a space separating two points or objects of the joist hanger 20. Accordingly, the size of the shim 32 as shown in FIGS. 12-13 would substantially prevent horizontal movement of the shim 32 between the two vertically extending sides of the joist hanger 20. The examiner even noted in the May 17, 2007 Office action that “Figures 12-15 appear top [sic] show a shim having a width approximately the width of the support member base . . . .” “[H]aving a width approximately the width of the support member base” while disposed between the joist hanger 20, would substantially prevent horizontal movement therebetween. A reasonable artisan would be apprised of this limitation for the purposes of Section 112, first paragraph; and since there are no other reasonable interpretations, the claims are definite for the purposes of Section 112, second paragraph.

Independent claims 1, 8, 14, and 22 and new claim 23 distinguish the present invention over King. King discloses a wedge mechanism that expands to fill a space generated by movement of one part relative to another. Specifically, King discloses a shim that comprises a lower wedge member 5 slidably engaged with an upper wedge member 6, which run longitudinally relative to one another across an incline plane as generally shown in FIGS. 1 and 2. As the space between the support 7 and the bar 8 increases, the spiral spring 18 as coupled to the bolt 11 forces the upper wedge member 6 to move

horizontally and vertically relative to the lower wedge member 5 along the incline plane.

There are several deficiencies in the King wedge mechanism solved in the present application. First, the upper wedge member 6 must move horizontally relative to the lower wedge member 5 in order to continue maintaining contact with the support 7 and the beam 8. Horizontal movement thereof necessarily requires that the King shim does not substantially maintain contact with the bottom side of the beam 8 at all times. This causes instability. For example, a gap forms underneath the right portion of beam 8 when the upper wedge member 6 moves horizontally along the incline plane. A heavy beam will begin to twist clockwise about the pivot point created in the upper right-hand corner of the horizontally sliding upper wedge member 6. The King shim must allow for this horizontal movement in order to maintain vertical contact with both the support 7 and the beam 8. Too much horizontal movement could be detrimental to the overall stability of the support system.

The present invention, as now claimed in amended independent claims 1, 8, 14 and 22 and new claim 23, solves the aforementioned problems in the King shim. The present invention claims a shim only capable of vertical movement between the wooden member support. The shim of the present invention continually maintains even contact along the underside of the wooden member as the wooden member pulls away from the support base thereof. Appropriately, the shim does not shift horizontally as in King. Thus, the shim of the present invention eliminates any potential beam twisting and enhances the stability of the overall retrofit system for supporting the wooden member relative to the wooden member support.

Moreover, preventing horizontal movement of the King shim effectively renders King inoperable. The upper wedge member 6 must move horizontally relative to the lower wedge member 5 along the inclined plane in order to function properly. Absent such horizontal movement thereof, the upper wedge member 6 and the lower wedge member 5 would no longer be able to translate the weight of the beam 8 to the support 7 – rendering the shim mechanism

useless. Accordingly, King teaches away from any shim that substantially prevents horizontal movement therein. Using King as the basis for an obviousness rejection thereto would be inappropriate.

Amended independent claims 1, 8, 14, and 22 and new claim 23 recite limitations not disclosed in King. Therefore, King can not anticipate nor render obvious any of pending claims 1, 5, 6, 8, 11, 12, 14, 15, 18, 19, 22, or 23. Reconsideration is respectfully requested.

Respectfully submitted,

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